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BOGART, MICHAEL G	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/613,842
Filing Date: July 03, 2003
Appellant(s): ANDERSON ET AL.

Walter W. Karnstein
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06 August 2007 appealing from the Office action mailed 21 March 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed. It is noted that there is no Office action dated 15 December 2006.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Copending application 10/412,057 has issued as US Pat. No. 7,201,732 and the obvious type double patenting rejections based upon that application are no longer provisional. The substantive basis for the rejections have not changed.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 6,299,305	Miwa	10-2001
US 6,270,467	Yee	8-2001
US 6,159,186	Wickham *et al.*	12-2000
US 5,368,582	Bertera	11-1994
US 5,171,306	Vo	12-1992
US 7,201,732	Anderson *et al.*	4-2007

(9) Grounds of Rejection

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6, 17, 18, 28 and 30-32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-49 of U.S. Patent No. 7,201,732 (Anderson *et al.*). Although the conflicting claims are not identical, they are not patentably distinct from each other because the Anderson patent claims every material limitation of the instant invention.

Claims 9-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-49 of U.S. Patent No. 7,201,732 (Anderson *et al.*) in view of Bertera (US 5,368,582 A).

The Anderson patent claims every material limitation of the instant invention except for a spectacle style frame to hold the device in place.

Bertera teaches a spectacle style frame that includes means for introducing fluid to the eyes of a wearer (see figure 1, infra).

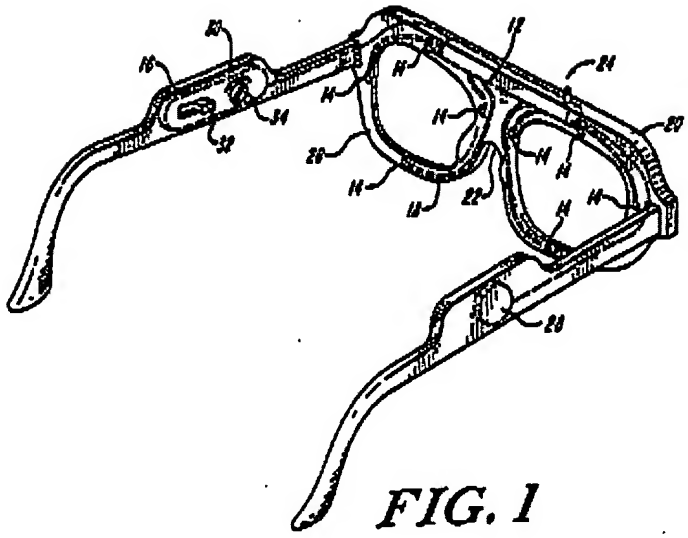


FIG. 1

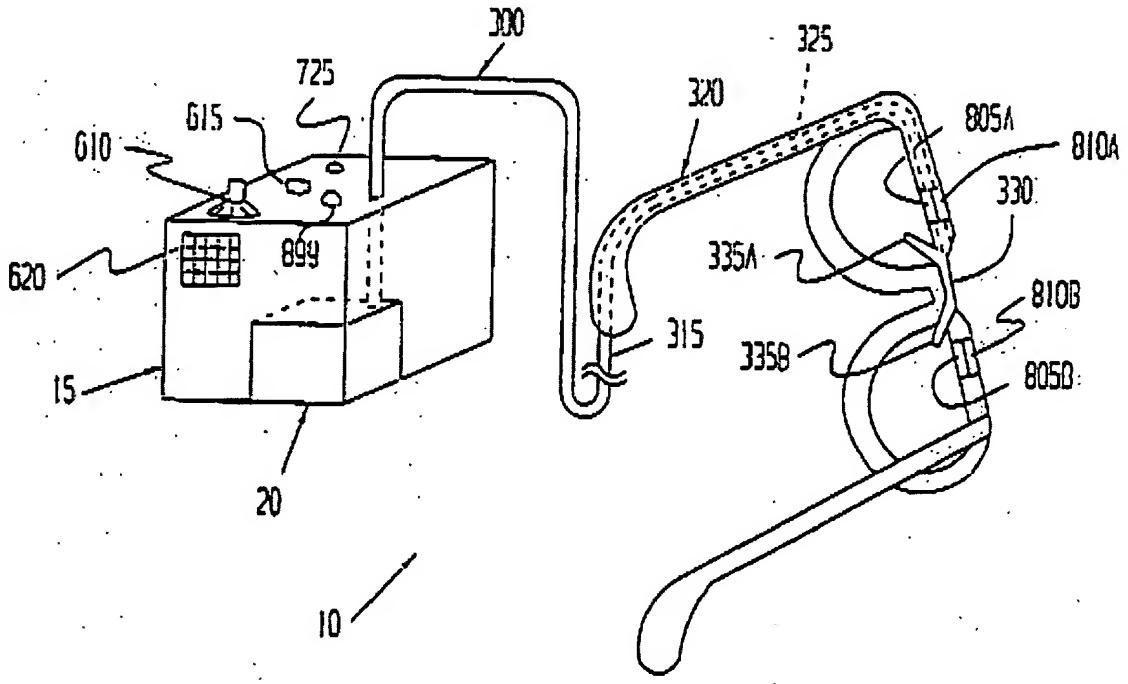
At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the frame member of Bertera with the dispensing mechanism of the Anderson patent in order to provide a means for holding the mechanism in place in front of a wearer's eyes.

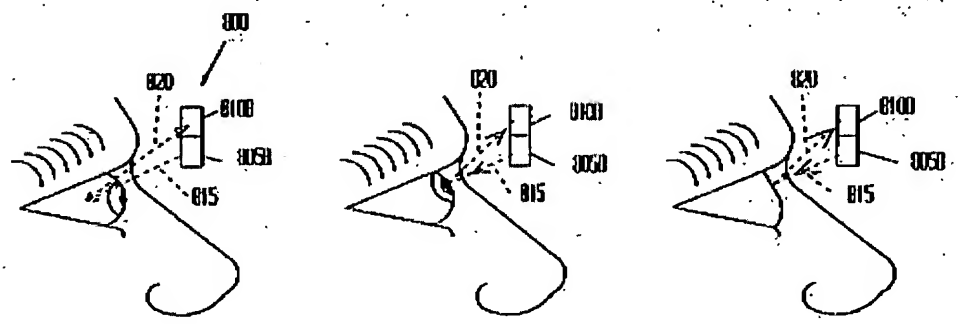
Claims 20 and 22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-49 of U.S. Patent No. 7,201,732 (Anderson *et al.*) in view of Vo (US 5,171,306 A). The Anderson patent claims every material limitation of the instant invention except for a detector capable of detecting the position of an eye relative to a dispenser and a spectacle style frame to hold the device in place.

Vo teaches a spectacle frame style eye drop delivery system (10) that detects an eyes position relative to a dispensing apparatus (320)(col. 8, line 65-col. 9, line 30)(see figures 1 and 6A-6C, infra). This permits dispensing of eye drops only when the eye is positioned in a disadvantageous position.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the frame member and eye position detection means of Vo with the dispensing

mechanism of the Anderson patent in order to provide a means for holding the mechanism in place in front of a wearer's eyes and to avoid dispensing of eye drops when the eye is positioned in a disadvantageous position.





Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-10, 14-16, 18, 19 and 28-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yee (US 6,270,467 B1).

Regarding claims 1, Yee teaches an eye-positioning device (10) capable of assisting a subject in positioning an eye (2)(to an open or closed position of the eye; also, the visual indicator on the monitor (6) can be used to draw a patient's focus); and

An applicator capable (60, 66, 75, 76) of dispensing fluid into an eye (2)(see figures 8 and 11, infra).

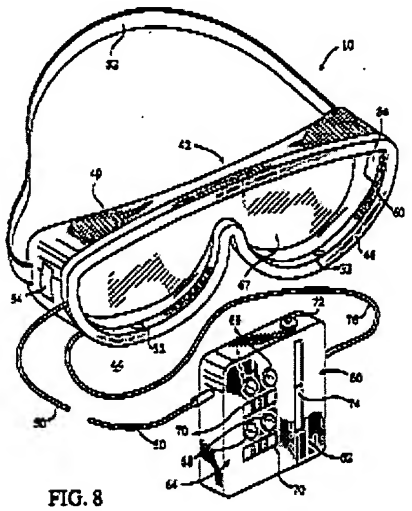


FIG. 8

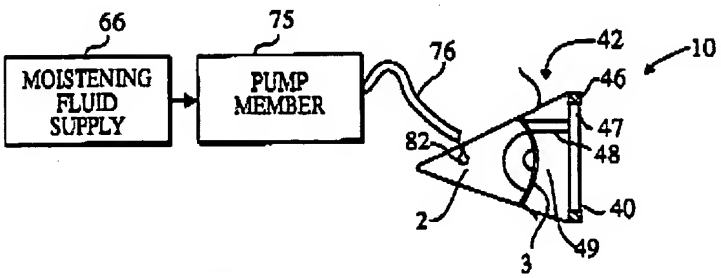


FIG. 11

Regarding the functional limitations, apparatus claims must be structurally distinguishable from the prior art. MPEP § 2114.

Regarding claim 2, Yee teaches an eye position detector (16)(detects whether eye is in open or closed position) and a feedback device (30, 32, 34, 36).

Regarding claim 28, Yee teaches an eye position detector (16) and a dispensing means (66, 75, 76).

Regarding claims 3, 4, 30 and 31, Yee teaches a feedback device that provides audible or visual cues (30, 32, 34).

Regarding claim 5, Yee teaches a display monitor (6)(see figure 4, infra). A conventional computer display monitor is capable of displaying an image of an eye.

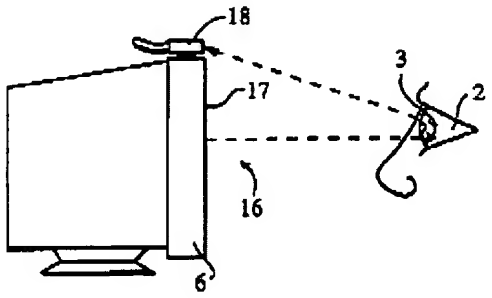


FIG. 4

Regarding claims 6, and 29, Yee teaches an image pick-up device (16) and an image processor (5, 12, 64).

Regarding claim 8, Yee teaches a feedback device (30, 32, 34, 36) capable of outputting feedback signals to a user.

Regarding claims 9 and 10, Yee teaches a spectacle frame (40) and a fluid dispenser (60) supported by the frame (40)(figure 8).

Regarding claim 14, Yee teaches a controller (64, 90) to actuate the fluid dispenser (60).

Regarding claim 15, Yee teaches that the controller (64, 90) dispenses a predetermined dosage of fluid (82)(col. 12, lines 44-57).

Regarding claim 16, Yee teaches a fluid reservoir (66).

Regarding claim 18, Yee teaches a user interface (5, 68) that can be programmed to set the operating parameters of the apparatus (10).

Regarding claim 19, Yee teaches a graphical interface (6, 70).

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 11-13, 17 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yee as applied to claims 1-6, 8-10, 14-16, 18, 19 and 28-31 above, and further in view of Bertera.

Yee does not disclose expressly that the dispenser includes a thermal droplet jet dispenser.

Bertera teaches a spectacle-like device (10) that includes thermal or piezoelectric jet dispensers (14) to apply treating fluid into an eye (col. 5, lines 1-12; col. 9, lines 3-17)(see figure 1, supra).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to use the jets of Bertera as the dispenser of Yee in order to provide a structure that is know in the art to be suitable for this purpose.

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Yee as applied to claims 1-6, 8-10, 14-16, 18, 19 and 28-31 above, and further in view of Miwa (US 6,299,305 B1).

Yee does not expressly disclose that the image pick-up device is a CCD camera.

Miwa teaches an ophthalmic apparatus that uses a CCD camera (10) to detect the dryness of an eye.

At the time of the invention, it would have been obvious to employ a CCD camera as taught by Miwa as the image capture device of Yee in order to provide an image capture device that is known in the art to be suitable for capturing diagnostic images in a medical setting.

Claims 20, 22 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yee as applied to claims 1-6, 8-10, 14-16, 18, 19 and 28-31 above, and further in view of Vo.

Yee does not expressly disclose an eye position detector that detects an eye position relative to the dispensing apparatus.

Vo teaches a spectacle frame style eye drop delivery system (10) that detects an eyes position relative to a dispensing apparatus (320)(col. 8, line 65-col. 9, line 30)(see figures 1 and 6A-6C, infra). This permits dispensing of eye drops only when the eye is positioned in a disadvantageous position.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the frame member and eye position detection means of Vo with the dispensing mechanism of Yee in order to provide a means for holding the mechanism in place in front of a wearer's eyes and to avoid dispensing of eye drops when the eye is positioned in a disadvantageous position.

Claims 24-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yee and Vo as applied to claims 1-6, 8-10, 14-16, 18-20, 22, 23 and 28-31 above, and further in view of Wickham *et al.* (US 6,159,186 A; hereinafter "Wickham").

Yee and Vo do not disclose expressly that the image capture device is a digital camera.

Regarding claims 24 and 25, Wickham teaches an infusion delivery system that employs a digital camera (28) as an image uptake device, and a image processor (34) capable of processing that camera's images (col. 2, line 66-col. 3, line 13).

At the time of the invention, it would have been obvious to employ a digital camera and digital image processing as taught by Wickham as the image capture device of Yee and Vo in order to provide an image capture device that is known in the art to be suitable for capturing diagnostic images in a medical setting.

Regarding claims 26 and 27, Yee teaches a controller (64, 90) which controls a fluid dispenser (60).

(10) Response to Argument

Regarding claims 1 and 7, applicants assert that Yee, alone or in combination with Miwa, does not disclose an eye-positioning device for assisting a subject in positioning an eye. This argument is not persuasive because the device of Yee assists a user in moving their eye from an open to a closed position that occurs during blinking of the eye. Control member (64) serves as both the blink signal (32)(eye open/closed position) monitor and nebulizer controller, permitting a user of the device to only activate the nebulizer when the eye is in an open position.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that Yee fails to teach a device that detects the position or orientation of an eye in a socket) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding claims 2 and 28, applicants assert that Yee does not disclose an eye position detector. This argument is not persuasive because Yee teaches a blink monitor (16) which determines if the eye is in an opened or closed position. It permits a user to move their eye to a closed position during a blink once the signal is provided to the user.

Further regarding claims 2 and 28, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Yee does not disclose a camera or other type of image pick-up device) are

not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding claim 5, applicants assert that Yee does not teach a display for performing the claimed functions. This argument is not persuasive because Yee teaches a computer display monitor (6) that is capable of performing the claimed functions, such as displaying a real time image of an eye or any other image provided by computer (5) or phototransistors (18)(col. 9, lines 22-40). Apparatus claims must be structurally distinguishable over the prior art. MPEP § 2114. If the prior art apparatus can has the claimed structure and can perform the claimed functions, it meets the claim.

Regarding claim 6, applicants assert Yee does not disclose a recited image pick-up device, and that Yee's phototransistor measures only light intensity, which is a coarse measurement compared to an image capture. This argument is not persuasive because although the phototransistor of Yee may not capture the full spectrum of light and color visible to the human eye, it is capable of capturing an image of light reflected off an eye.

Applicants further assert that Yee does not teach an image processor. This argument is not persuasive because Yee teaches a computer (5) that is capable of processing an image. See discussion of MPEP § 2114, supra.

Regarding claims 8, 11-13, 17 and 32, applicants assert that Yee alone, or in combination with Bertera, does not disclose a feedback device corresponding to directions for moving an eye to a desired position. This argument is not persuasive because Yee teaches a light that signals a user to blink, which entails moving their eye to the closed position.

Regarding claims 20, 22 and 23, applicants assert that Yee and Vo do not disclose a feedback device for providing feed back information to assist in moving an eye to a new position relative to a dispensing apparatus. This argument is not persuasive because Vo teaches eyelid detecting means (800) that determine the position of the eye/eyelid (open or closed) relative to frame (320)(col. 8, line 65-col. 9, line 30).

Regarding claim 23, applicants assert that Yee and Vo do not disclose an image capturing device. This argument is not persuasive because although the phototransistor of Yee may not capture the full spectrum of light and color visible to the human eye, it is capable of capturing an image of light reflected off an eye.

Applicants further assert that Yee does not teach an image processor. This argument is not persuasive because Yee teaches a computer (5) that is capable of processing an image. See discussion of MPEP § 2114, supra.

Regarding claim 24, applicants assert that Wickham does not teach a processor operable to process a digital image of an eye. This argument is not persuasive because Wickham discloses a digital camera (28) and processor (34) that can process any digital image.

Further regarding claim 24, applicants assert that Yee alone, or in combination with Vo and Wickham, does not disclose a feedback device corresponding to directions for moving an eye to a desired position. This argument is not persuasive because Yee teaches a light that signals a user to blink, which entails moving their eye to the closed position.

Applicants assert that there is not motivation to combine Wickham with Yee and Vo. This argument is not persuasive because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no

change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S.__, 82 USPQ2d 1385, 1396 (2007).

Regarding the double patenting rejection of claims 1-4, 6, 17 and 18 over the '057 application (now the Anderson patent), applicants assert that claims 2-50 of the '057 application (now claims 1-49 of the Anderson patent) are directed to a device for administering material to an eye that includes a blink detector.

Applicants further assert that acclaims 2-50 of the '057 application (claims 1-49 of the Anderson patent) do not disclose an eye-positioning device for assisting a subject in positioning an eye. This argument is not persuasive because claims 1-49 of the Anderson patent are directed to a device that assists a user in moving their eye from an open to a closed position that occurs during blinking of the eye. Control member (64) serves as both the blink signal (32)(eye open/closed position) monitor and nebulizer controller, permitting a user of the device to only activate the nebulizer when the eye is in an open position.

Regarding the double patenting rejection of claims 9-16, applicants assert that claims 2-50 of the '057 (claims 1-49 of the Anderson patent) application do not teach an eye position detector. This argument is not persuasive because Yee teaches a blink monitor which determines if the eye is in an opened or closed position. It permits a user to move their eye to a closed position during a blink once the signal is provided to the user.

Regarding the double patenting rejection of claims 20 and 22, applicants assert Vo does not disclose a feedback device for providing feed back information to assist in moving an eye to a new position relative to a dispensing apparatus. This argument is not persuasive because Vo

teaches eyelid detecting means (800) that determine the position of the eye/eyelid (open or closed) relative to frame (320)(col. 8, line 65-col. 9, line 30).

Regarding the double patenting rejection of claims 28 and 30-32, applicants assert that the '057 application (now Anderson patent) does not claim detecting means

This argument is not persuasive because the Anderson patent claims a blink monitor which determines if the eye is in an opened or closed position. It permits a user to move their eye to a closed position during a blink once the signal is provided to the user.

(11) Related Proceedings

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael Bogart

Conferees:

Tatyana Zalukaeva

TATYANA ZALUKAEVA
SUPERVISORY PATENT EXAMINER

Patricia Bianco